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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,352

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EXAMINER

TOLIN, MICHAEL A

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

07/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SUGHRUE@SUGHRUE.COM

Office Action Summary	Application No. 10/552,352	Applicant(s) GASTALDI ET AL.	
	Examiner MICHAEL A. TOLIN	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-7-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 5-7 in the reply filed on 02 April 2008 is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (US 5972144) in view of Jeffers (US 2500494).

Hsu teaches a method of making a decorative article of resin comprising the steps of preparing a rubber mold, pouring a resin into the rubber mold, and removing the hardened resin from the mold (column 2, lines 14-33). While Hsu does not explicitly recite a step of removing the hardened resin from the mold, one of ordinary skill in the art would readily appreciate that such a step is provided since the mold is not intended to become part of the finished article.

Hsu does not recite the use of a mold having several identical figures. However, such is well known in the art of casting. For example, Jeffers explains that it is desirable

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to provide a plurality of molds (recessed figures) in a single molding unit (mold) so as to permit production of the articles being formed in multiples (column 2, lines 51-54; Figure 1) and that a plurality of molds (recessed figures) are provided for convenience in casting in multiples (column 3, lines 37-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the mold of Hsu with the claimed limitation of multiple identical figures because one of ordinary skill in the art would have been motivated to conveniently produce multiple articles in accordance with well known methods as evidenced by Jeffers.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of Jeffers is applied to claim 5 above, and further in view of Mohiuddin (US 4350739).

Hsu does not recite coating the mold surface prior to pouring the resin. However, such is known in the art of molding for providing a uniform and firmly adherent coating with a reduction in the number of post-molding operations and the elimination of mold release material. Exemplary coatings include decorative and protective coatings such as paints. See Mohiuddin (column 1, lines 1637, lines 45-47, lines 55-58; column 2, lines 8-12, lines 18-29, lines 61-63; column 3, lines 9-12, lines 36-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the claimed step of coating because one of ordinary skill in the art would have been motivated to provide a decorative or protective coating in a manner having the above noted advantages in accordance with the teachings of Mohiuddin.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of Jeffers is applied to claim 5 above, and further in view of Tukakoshi (US 5226993).

Hsu does not recite a manner of adhering the decorative article to a substrate. However, it is well known to adhere such decorative articles to a substrate using bi-adhesive sheet, as evidenced by Tukakoshi (Abstract; column 1, lines 8-25; column 2, lines 17-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the claimed step of applying a bi-adhesive sheet because one of ordinary skill in the art would have been motivated to provide known suitable means for adhering a decorative article to a substrate, as evidenced by Tukakoshi.

6. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tukakoshi in view of Hsu and Jeffers.

The claims are rejected here in the alternative to provide stronger motivation for attaching a bi-adhesive sheet. Tukakoshi is directed to forming a decorative article of the type which is adhered to a substrate such as a passenger car with bi-adhesive tape (Abstract; column 1, lines 8-48; column 2, lines 11-31). While Tukakoshi suggests forming the decorative article by injection molding (column 2, lines 56-58), other suitable methods of molding are well known. Hsu and Jeffers are applied as above in the rejection of claim 5 for teaching such a suitable alternative which involves casting into a rubber mold having a plurality of identical figures. The examiner's position is that selection from among known suitable molding methods involves no more than routine

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design choice for one having ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to form a decorative article of the type shown by Tukakoshi by a casting method suggested by Hsu as modified by Jeffers because one of ordinary skill in the art would have been motivated to select from among known suitable molding methods as a matter of routine design choice.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tukakoshi in view of Hsu and Jeffers as applied to claims 5 and 7 above, and further in view of Mohiuddin.

Mohiuddin is applied as above in the rejection of claim 6.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. TOLIN whose telephone number is (571)272-8633. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Tolin/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791